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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,163	06/25/2001	Mark R. Stiffler	YOR920010116US1	1378

7590 07/28/2006

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EXAMINER	
WEBB, JAMISUE A	

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/891,163	STIFFLER, MARK R.	
	Examiner	Art Unit	
	Jamisue A. Webb	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 October 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-68* is/are pending in the application.

4a) Of the above claim(s) *17-61* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16 and 62-68* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *20010625*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Invention I in the reply filed on 10/19/05 is acknowledged. Even though the applicant has stated that the election is with traverse, because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-7, 10, 14, 16 and 62-68 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 1, 4, 7, 62, 65 and 68 recites the limitation "said requester". There is insufficient antecedent basis for this limitation in the claim.

5. With respect to Claim 2, 5, 10 and 14: these claims are dependent claims which is meant to further limit the receiving step in the independent claims which is "receiving a request for requirements for a selected country", which means the request is for a single country. It does not claim that the request is for one or more countries, it is limited to only one country. Therefore, by reciting that the request is now for a plurality of countries, causes the claim to be unclear, due to the fact that the claim is changing the receiving step, not further limiting it. The examiner suggests changing the wording in Claim to "one or more selected countries".

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-16 and 62-65 are rejected under 35 U.S.C. 102(e) as being anticipated by Lederer, Jr. et al. (2002/0023109).

8. With respect to Claims 1, 4, 7-9, 12, 13, 16, 62, 65 and 68: Lederer discloses the use of a method, system and program product with instructions for operating a computer comprising the steps and means for:

a. Storing core requirements applicable to a plurality of countries (Paragraph 0038);

b. Storing country-specific requirements applicable to respective countries (Paragraph 0038, Lederer also discloses the use of MSDS, which give standardized shipping requirements, which the examiner considers to be core requirements);

c. Storing on said computer country-specific summary requirements (Paragraph 0042, the examiner considers the tables to be in the form of a summary);

d. Receiving a request for a summary report of requirements for a selected country (see abstract, and Paragraph 0038);

e. Providing core as well as country-specific requirements (see abstract and paragraphs 0038 and 0040), it is the examiner's position that if the country specific

requirements are provided, them it is inherent that the process of Lederer determines if they are there, due to the fact that how can they be provided if they weren't first determined they were there/stored.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 2, 5, 10 and 14 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lederer Jr., et al.

11. With respect to Claims 2, 5, 10 and 14: Lederer discloses the system can be used for multiple shipments, therefore there would have to be a request with a plurality of countries. Furthermore, It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the request by for multiple countries, since it has been held that a mere multiplicity of parts or steps involves only routine skill in the art. *St. Regis Paper Co. v Bemis Co.* 193 USPQ 8. Therefore it would have been obvious to Lederer to have the request be for multiple carriers, do to the fact that requesting information on multiple countries, would have been at the level of ordinary skill in the art.

12. With respect to Claims 3, 6, 11, 15, 63, 64, 66 and 67: Lederer discloses providing country specific regulations as well as core regulations, however does not expressly state providing the results in a matrix format. At the time the invention was made, it would have been

an obvious matter of design choice to a person of ordinary skill in the art to have the results displayed in a matrix format, because Applicant has not disclosed that displaying the results in a matrix format provides an advantage or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the results disclosed in list format, because they are both provided to the user, just organized in different ways. Therefore, it would have been an obvious matter of design choice to modify Lederer to provide the results in matrix format, as specified in Claims 3, 6, 11, 15, 63, 64, 66 and 67.

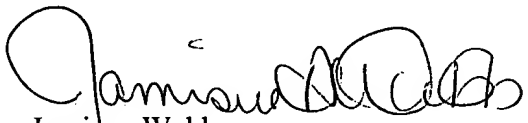
Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Harbor Inc. (www.openharbor.com) discloses a trade automation system which aids in international shipping, Hjelm and McCarthy disclose an international electronic transaction which ensures compliance with international shipping regulations and Walker et al. (US 2002/0095355) discloses the use of a computer-implemented international trade system and method which ships items based on international shipping regulations.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (571) 272-6811. The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jamisue Webb
Patent Examiner
Art Unit 3629